

REMARKS

This Amendment is prepared in response to the Office Communication mailed on 9 February 2007 and to the Office action mailed on 30 May 2006 (Paper N^o. 051506).

In the un-numbered Paper dated on the 9th of February 2007, the Examining staff newly raised two questions.

In response to the first question, Applicant notes that 37 CFR §1.121(b)(1)(ii) makes no prohibition against use of both a strikeout and double brackets to indicate deletion of text or punctuation from a claim.

In response to the second question, the presence of *comprised of* is proper in the presence of this term in Applicant's *Amendment* timely filed on the 2nd of October 2006 and the listing of claims pursuant to 37 CFR §1.121(c). As decreed by 37 CFR §1.121(c),

“[t]he listing of the claims, *including of the text* of the claims, in the amendment document *will serve to replace all prior versions of the claims* in the application.”

37 CFR §1.121(c) was expressly written by the Office to avoid questions such as those raised by the un-numbered Paper. Consequently, the issue of the un-numbered Paper is both unnecessary and improper under 37 CFR §1.121(c), and incomplete under 37 CFR §1.104(a) and (b). Written indication in subsequent non-final Office correspondence stating that these questions have been withdrawn, is respectfully requested.

Status of Claims

By this Second Substitute Amendment, claims 1 through 31 are being canceled without prejudice or disclaimer of their subject matter, and claims 32 through 62 are

being added. Thus, claims 32 through 62 are pending in this application. It is noted that previous claims 1 through 31 correspond to newly presented claims 32 through 62.

As a result of the restriction requirement of the 27th of January 2006, previous claims 18 through 31 (new claims 49 through 62) were withdrawn from further consideration. Newly presented claims 32 through 48, 51, 53 through 55, 57 and 60 reflect previous claims 1 through 17, 20, 22 through 24, 26 and 29 as amended.

Election/Restrictions

In the Office action of 30 May 2006, the Examiner states that the Applicant's grounds for traversal for the restriction requirement is not persuasive, and made the requirement final.

Applicant respectfully opposes this restriction requirement for the reasons stated in the previous Response filed on the 27th February 2006, which reasons are incorporated into this Amendment by reference thereto.

In addition, it should be noted that the following three patents are in fact classified in both class 271, subclass 3.01 and class 271, subclass 264:

| | PAT. Nº | Title |
|---|----------------|---|
| 1 | 6.123.328 | <i>Conveying Belt Mechanism For An Automatic Feeder</i> |
| 2 | 5.622.365 | <i>Sheet Feeding Method And Apparatus</i> |
| 3 | 5.529.211 | <i>Apparatus For Conveying, Accommodating And Paying Out Bank Notes</i> |

In other words, it has been the policy as well as the practice of the Office during the

development of this field of the sheet handling art, to concurrently search both class 271, subclass 3.01 and class 271, subclass 264 while simultaneously examining, in a single application, claims that define subject matter spanning both classes.

Moreover, as previously explained to the Examiner, the *Manual of Patent Examining Procedure* §806.03 states that:

“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween **should never be required**. This is because the claims are different definitions of the same disclosed subject matter, varying in breadth or scope of definition” (emphasis added).

In the instant application, the claims are directed to the same essential characteristics; restriction under 37 CFR §1.142 can not be based upon either independence or distinctiveness. Accordingly, the restriction remains improper under current Office practice; withdrawal of the restriction requirement and examination of all pending claims are respectfully requested.

Claim Rejections - Second Paragraph Of 35 U.S.C. § 112

A. Previous Claims 1 through 16 are rejected under the second paragraph of 35 U.S.C. §112 for lack of antecedent basis and for indefiniteness.

In support of this rejection, the Examiner provides the following examples:

Claim 1: the limitation “the items” in line 2 lacks antecedent basis. As amended, new claim 32 recites –flexible objects–.

Claim 3: the limitation “the guide means” in lines 3-4 lacks antecedent basis. As amended, new claim 34 substitutes –guide– for “guide means.”

Claim 4: the limitation “their cut-edge side” in lines 3-4 lacks antecedent basis. In

new claim 35, the phrase “their cut-edge side” is replaced by --corresponding cut-edge sides--.

Claim 7: the limitation “their main conveying direction” in line 2 lacks antecedent basis. In new claim 38, the phrase “their main conveying direction” has been deleted.

Claim 8: the wording “after this” in line 2 is not clear. After what element is the transfer module arranged? As amended, in new claim 39, the phrase “after this” is omitted.

Claim 9: it is unclear if the guide surface is concave, convex, has sections with different inclinations, or some combination of these different limitations. Remembering that claim 9 is a dependent claim, the Examiner’s interpretation of claim 9 is correct; to avoid archaic issues of interpretations of the second paragraph of 35 U.S.C. §112 from earlier decades, new claim 40 is re-written in an even broader manner to encompass all possibilities of inclination.

The foregoing amendments address each of these questions, and render the basis for this rejection moot. Withdrawal of the rejection is respectfully requested.

Claim Rejections - 35 U.S.C. §102(b)

B. Previous Claims 1, 5 and 6 through 16 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent N^o. 3,334,890 to La Bombard.

Newly presented claims 32, 36 and 37 are discussed in conjunction with rejected claims 1, 5 and 6, in support of the rejection of Claims 1, 5 and 6 through 16 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent N^o. 3,334,890 to La Bombard, the Examiner provides the following observations:

“Regarding claim 1, Figs. 1-6 disclose a method for

processing and separating an imbricate formation of flexible, flat objects during product feed, comprising continuously feeding the items (30) in an essentially regular formation to a transfer module (including 121) and transferring the items from the transfer module (including 121) to a conveyor module (including 54), wherein flat objects (30) are fluently fed to a guide (including 141 and 142) within the transfer module (including 121), and the flat objects (30) during their conveying are brought into an obliquely standing position (Fig. 2) by the guide (including 141 and 142), and that the flat objects (30) from this position are separated in a defined number (e.g., one at a time) from the remaining flat objects by a separator(54), and conveyed away by a conveyor (including 109).”¹

This assertion is a fanciful reading of LaBombard ‘890. Generally, LaBombard ‘890 discloses an “end feed magazine 121” that “is angularly adjustable and vertically movable² that receive cut, creased, printed matter “in a shingled formation on a stacking apron 47.” Contrary to the Examiner’s assertion, LaBombard ‘890 expressly teaches that “the operator ... can repeatedly fill the magazine at about waist level height.”³ A “vibratory effect” is required however, to enable “blanks” to:

“be introduced at the entrance of the magazine, in shingled, recumbent condition, [that] will automatically rise to stand upright on an lower edges before reaching the exit of the magazine, thus permitting direct feed to the magazine from the standing apron, if desired, and eliminating manual refill entirely”.⁴

Consequently, LaBombard ‘890 is devoid of Applicant’s “continuously feeding ... in an

¹ Paper N^o 051506, page 4.

² LaBombard ‘890, column 4, lines 14 and 15.

³ LaBombard ‘890, column 1, lines 50-52.

⁴ LaBombard ‘890, column 1, lines 63-69.

essentially regular formation” in combination with “the flat objects during their conveyance are brought into an obliquely standing position by the guide”

Second, the Examiner’s assertion improperly reads into previous claim 1, a feature that Paper N^o 051506 expressly attributes to dependent previous claim 12, namely Applicant’s “rim or the abutment”. In point of fact, “each extension 141 or 142” of LaBombard ‘890 can not serve to anticipate different constituent elements of previous claim 12 (*i.e.*, both Applicant’s “guide”⁵ recited in claim 1, as well as Applicant’s “brim or the abutment”⁶ which is recited in previous dependent claim 12) which is dependent upon previous parent claim 1, and to also be read to anticipate a constituent element of previous parent claim 1 when that element is not a limitation of previous claim 1, but of its previous dependent claim 12 and of newly presented claim 43.

Under 35 U.S.C. §102, it is error to assume that two structures are the same or equivalent simply because they perform the same function. The Federal Circuit has held it error to assume that two structures are the same or equivalent simply because they perform the same function. *Roton Barrier, Inc. v. Stanley Works*, 79 F.3d 1112, 1126-27 (Fed. Cir. 1996); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934 (Fed. Cir. 1987) (en banc) (“Pennwalt erroneously argues that, if an accused structure performs the function required by the claim, it is per se structurally equivalent”), *cert. denied*, 485 U.S. 961 (1988). Infringement (or anticipation) is found only if the claimed function is performed by either the same structure (or acts) that the specification describes or else by an equivalent of the structure (or acts). *Texas Instruments Inc. v. United States Int’l*

⁵ Paper N^o 051506, page 4.

⁶ Paper N^o 051506, page 5.

Trade Comm'n, 805 F.2d 1558, 1562, 231 USPQ 833, 834-35 (Fed. Cir. 1986).

Accordingly, this rejection is improper under the all elements rule. Withdrawal of the rejection and allowance of new claims 32 through 37, 41 through 49, 53 through 56 and 60 through 62 is respectfully requested.

In support of the rejection of previous claim 5, Paper N^o. 051506 stated that,

“Regarding claim 5, column 4, lines 41-52 and lines 64-72 disclose that the erection of the flat objects (30) is effected by active braking or acceleration of the flat objects (30) at least one edge by way of conveyor means (including 125).”⁷

Applicant submits that in point of fact, LaBombard ‘890 does not support this assertion, and instead, in column 4, lines 41-52, teaches that,

“Each extension 141 or 142 is connected by a pivoted link 145 to an element 137 whereby it is oscillated by the vibrator with the blank supports, but in an inclined plane relative thereto. ... As lifts of blanks are placed in the magazine in vertically disposed condition, the vibration of the blank supports and extensions, causes any blanks at the rear of the stack which may be shingled, and not normal to the supports, to advance along the supports until the stack is closely packed with all blanks normal to the supports. The endmost blanks in the stack vibrate up the incline of the extensions to fan out and separate ready of individual passage through the gateway 67.”⁸

Nothing in this excerpt supports the assertion of Paper N^o. 051506 that LaBombard ‘890 teaches,

“that the erection of the flat objects (30) is effected by active braking or acceleration of the flat objects (30) at least one

⁷ Paper N^o 051506, page 4.

⁸ LaBombard ‘890, column 4, lines 41-72.

edge by way of conveyor means (including 125).”⁹

Applicant submits therefore, that this rejection may not be maintained.

Turning now to previous claims 6, 7 and 11, and newly presented claims 37, 38 and 42, the Examiner wrote that:

Regarding claim 6, in as much as the device of the instant application has a folding-over means, so does the Bombard apparatus. In particular, whatever structure causes the sheets to be folded over from lying flat to an upright position can be considered folding over means.

Regarding claim 7, Fig. 2 shows that the flat objects (30) before removal are displaced transversely to their main conveying direction (i.e., left to right in Fig. 2).

With regard to claim 11, different elements are cited for the brim or abutment. Thus, all of the elements of claims 8 and 11 are included in the rejection of this claim, as outlined below.

Regarding claim 11, Figs. 1-6 show a device for carrying out the method according to claim 1 with a product feed, comprising a conveyor means (including 47) with a transfer module (including 121) arranged after this and with a conveyor module (including 54) for removal of flat objects (30) from the transfer module (including 121);

wherein the transfer module (including 121) contains a guide means (including 141, 142, 133 and 134) which comprises a guide surface which at least in regions is inclined with respect to the horizontal (Fig. 2), and that on the side proximal to the removal device there is arranged a brim or abutment (133 or 134). Also, the guide surface comprises guide elements (141 and 142) which serve for the regional acceleration and/or braking of the flat objects, See also column 4, lines 41-52 and lines 64-72 for an explanation of the acceleration of the flat objects.

Applicant respectfully disagrees, and notes that generally, LaBombard ‘890 discloses an “end feed magazine 121” that “is angularly adjustable and vertically movable that receive

⁹ Paper N° 051506, page 4.

cut, creased, printed matter “in a shingled formation on a stacking apron 47.”¹⁰ Contrary to the Examiner’s assertion, LaBombard ‘890 expressly teaches that “the operator ... can repeatedly fill the magazine at about waist level height.”¹¹ A “vibratory effect” is required however, to enable “blanks” to:

“be introduced at the entrance of the magazine, in shingled, recumbent condition, [that] will automatically rise to stand upright on an lower edges before reaching the exit of the magazine, thus permitting direct feed to the magazine from the standing apron, if desired, and eliminating manual refill entirely”¹².

Consequently, LaBombard ‘890 is devoid of Applicant’s “continuously feeding ... in an essentially regular formation” in combination with “the flat objects during their conveyance are brought into an obliquely standing position by the guide”

In support of the rejection of previous claims 11 through 16 corresponding to claims 42 through 47, respectively, the Examiner observed that:

Regarding claim 8, Figs. 1-6 show a device for carrying out the method according to claim 1 with a product feed, comprising a conveyor means (including 47) with a transfer module (including 121) arranged after this and with a conveyor module (including 54) for removal of flat objects (30) from the transfer module (including 121);

wherein the transfer module (including 121) contains a guide means (including 141, 142, 133 and 134) which comprises a guide surface which at least in regions is inclined with respect to the horizontal (Fig. 2), and that on the side proximal to the removal device there is arranged a brim or abutment (141 or 142).

¹⁰ LaBombard ‘890, column 4, lines 14 and 15.

¹¹ LaBombard ‘890, column 1, lines 50-52.

¹² LaBombard ‘890, column 1, lines 63-69.

Applicant submits that this assertion is untenable because it improperly reads into previous claim 1, a feature that Paper N° 051506 expressly asserts that “each extension 141 or 142” of LaBombard ‘890 anticipates Applicant’s “rim or the abutment”¹³ recited in previous dependent claim 8, while having earlier asserted that “each extension 141 or 142” of LaBombard ‘890 anticipates Applicant’s “guide.”¹⁴ In point of fact, “each extension 141 or 142”¹⁵ of LaBombard ‘890 can not serve to anticipate different constituent elements of previous claim 12 (*i.e.*, both Applicant’s “guide”¹⁶ recited in previous claim 1, as well as Applicant’s “rim or the abutment”¹⁷ which is recited in previous dependent claim 8) which is dependent upon parent claim 1, and to also be read to anticipate a constituent element of previous parent claim 1 when that element is not a limitation of previous claim 1, but of its previous dependent claim 8 and of newly presented claim 39. Accordingly, LaBombard ‘890 fails to make a *prima facie* teaching of anticipation.

In support of the rejection of previous dependent claim 9, Paper N° 051506 states that:

“Regarding claim 9, Figs. 1-6 show that the guide surface (including contact surfaces of 133, 134, 141 and 142) at least in regions is designed comprises at least two sections with a different inclination of the guide surface.”

¹³ Paper N° 051506, page 5.

¹⁴ Paper N° 051506, page 4.

¹⁵ LaBombard ‘890, column 4, line 45.

¹⁶ Paper N° 051506, page 4.

¹⁷ Paper N° 051506, page 5.

Previous Claim 9, which depends upon previous claim 1, defines a process with “objects ... fluently fed to a guide ..., and the ... object during their conveyance are brought into an obliquely standing position by the guide”, while LaBombard ‘890 teaches that:

“upstanding side guides 133 and 134 are provided, and guides 150 and 151 are provided at exit end 132, so that a stack 135 of blanks 30 is supported in the magazine with the blanks resting on their lower edges 42.”

No contribution to Applicant’s bringing the objects “into an obliquely standing position” as is defined by previous claim 9 is assigned by LaBombard ‘890 to “guides 133 and 134.” There is therefore, no demonstration of anticipation of previous claim 9 or newly presented claim 40, by LaBombard ‘890, and this rejection may not be maintained.

In arguing anticipation of previous claim 10, Paper N° 051506 asserts that,

“Regarding claim 10, Figs. 1-6 show that the inclination of the guide surface at least in regions is more than 30 degrees. For example, a portion of the guide surface on 133 is vertically oriented (approximately 90 degrees).”

This assertion is fiction because a guide which is “vertically oriented” at “approximately ninety degrees, in the side positions taught by LaBombard ‘890, is physically unable to bring objects “into an obliquely standing position” as does Applicant’s guide as is defined by previous claim 10 and now by claim 41.

In support of the rejection of previous claim 12, Paper N° 051506 asserts that “

”Regarding claim 12, Figs. 1-6 show that the brim or the abutment (141 or 142) is arranged movable with respect to the guide means (including 141, 142, 133 and 134).”

Rejected previous claims 8, and 9 through 12 depending thereon define, *inter alia*,

“wherein flat objects are fluently fed to a guide within said transfer module, and the flat objects during their conveyance

are brought into an obliquely standing position by the guide
....¹⁸

First, as was discussed earlier in this paper, this rejection is premised upon inconsistent attributions to elements 133, 134, 141 and 142 in support of the rejections of previous claim 1 and new claim 32, and its previous dependent claim 12 and new claim 43.

Second, as was also discussed in this paper, this rejection is improperly premised upon attribution of structural and operational characteristics to elements 133, 134, 141 and 142 which are at variance with those expressed by LaBombard '890.

Third, LaBombard '890, contrary to the assertions of the Examining staff,¹⁹ teaches a different structure that operates differently from what Applicant defines in previous claims 8, 9 and 12 and new claims 39, 40 and 43. Specifically, the stated object of LaBombard '890 is to avoid "stooping to refill the magazine" To attain this object, LaBombard '890 teaches that,

"In operation, the improved magazine 121 is positioned at the desired height to bring the top edge 41 of the endmost blank 30 in the stack 135 at the gateway 67".²⁰

In other words, the boxes are already in their upright position before magazine 121 is

¹⁸ Parent claim 1.

¹⁹ The Examining staff argues that LaBombard '890 teaches "the transfer module (including 121) contains a guide means (including 141, 142, 133 and 134) which comprises a guide surface which at least in regions is inclined with respect to the horizontal (Fig. 2), and that on the side proximal to the removal device there is arranged a brim or abutment (141 or 142)." In actuality, a thorough reading of LaBombard '890 fails to find the presence of these nouns.

²⁰ LaBombard '890, column 4, lines 57-59.

moved into position relative to “box folding machine 48.” As was earlier noted in this paper, to attain its expressed object of avoiding “stooping to refill the magazine ...” LaBombard ‘890 teaches that,

“In operation, the improved magazine 121 is positioned at the desired height to bring the top edge 41 of the endmost blank 30 in the stack 135 at the gateway 67”.²¹

In other words, LaBombard ‘890 contradicts the assertion of the Paper N^o. 051506:

“that Figs. 1-6 [of LaBombard ‘890] show that the brim or the abutment (141 or 142) is arranged movable with respect to the guide means (including 141, 142, 133 and 134).”²²

In short, LaBombard ‘890 fails to support the assertions set forth in Paper N^o. 051506; consequently, there is no anticipation.

In explanation of the rejections of previous claims 13, 14 and 15 and new claims 44, 45 and 46, respectively, Paper N^o. 051506 wrote that:

“Regarding claim 13, on the side of the guide means (including 141, 142, 133 and 134) which is proximal to the removal device (including 54), there are arranged active means for separating individual objects or groups of objects. See e.g., column 4, lines 41-52 and lines 64-72.

Regarding claim 14, column 4, lines 41-52 and lines 64-72 disclose that the brim or the abutment (141 or 142) comprises movable elements conveying the objects in the removal direction (i.e., up).

Regarding claim 15, Fig. 1 shows that in the removal region of the objects, there are arranged means for transversely displacing the objects.

²¹ LaBombard ‘890, column 4, lines 57-59.

²² Paper N^o. 051506, page 5.

Applicant notes however, that a thorough examination of LaBombard '890 fails to reveal "means for transversely displacing the objects."²³ Attribution of the language of Applicant's claim to LaBombard '890 when a thorough reading of that reference establishes the absence of that language, is evidence of a lack of anticipation. Although the rationale given for this rejection of previous claim 15 is not specific or complete under 37 CFR §1.104(a), the fallacy of the rationale given is that the attribution of extensions 141, 142 to Applicant's "brim or abutment" indicates that the Examiner's application of LaBombard '890 is deficient, and may not be maintained.

In support of the rejection of claim 16, the Examiner wrote that:

"Regarding claim 16, Fig. 1 shows that above the guide means, there are arranged retaining means (including 95) acting on the free edge of the objects."

In LaBombard '890 however, "Blank hold down means 95" acts upon blanks 30 after those blanks have "passed through feed gateway 67."²⁴ Consequently, LaBombard '890 fails to meet the definition of Applicant's process given by previous claim 16 and its previous parent claim 1. Moreover, under 35 U.S.C. §102(b), an anticipation rejection is valid, and can be sustained only if each and every element and limitation of the claim is found in a single prior art reference. *Schumer v. Laboratory Computer Sys., Inc.*, 308 F.3d 1304 (Fed. Cir. 2002); *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999); *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997); *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997). If a single element of the invention (or a single limitation of the claim) is missing, the reference does not anticipate. *Kloster*

²³ Applicant's Claim 15 and new claim 46.

²⁴ LaBombard '890, column 3, line 41.

Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). These rejections do not meet those legal requirements for anticipation, because LaBombard '890 does not disclose all of the limitations recited in the rejected claims.

Absent disclosure of all elements of these claims, there can be no anticipation under 35 U.S.C. §102(b). Withdrawal of these rejections of previous claims 1, 5 and 6 through 16 and allowance of new claims 32, 36 and 37 through 47 are therefore requested.

C. Previous Claims 1 through 3 and 6 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent N^o. 5,934,666 to Rabindran *et al*.

Previous Claims 1 through 3 and 6 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent N^o. 5,934,666 to Rabindran *et al*. In support of this rejection, the Examiner wrote that:

“Regarding claim 1, Figs. 1 and 7a-7d and column 5, lines 54-62 disclose a method for processing and separating an imbricate formation of flexible, flat objects during product feed, comprising continuously feeding the items (36) in an essentially regular formation to a transfer module (38) and transferring the items from the transfer module (38) to a conveyor module (column 5, lines 58-62), wherein flat objects (36) are fluently fed to a guide (near 306) within the transfer module (38), and the flat objects (36) during their conveying are brought into an obliquely standing position (Figs. 7c and 7d) by the guide, and that the flat objects (36) from this position are separated in a defined number from the remaining flat objects by a separator (at 38), and conveyed away by a conveyor (column 5, lines 58-62).”²⁵

By its own language, Rabindran '666 contemplates an “in-feed magazine apparatus and

²⁵ Paper N^o 051506, page 7.

method” that uses “two parallel paddles which are successively repositioned on the documents feed path within a stack of documents in a non-overlapping manner and where such paddles are driven separately for purposes of maintaining the documents in a substantially vertical array.”²⁶ In contradistinction, Applicant’s previous claims 1 through 3 define a process characterized by “continuously feeding ... in an essentially regular formation ..., wherein flat objects are fluently fed to a guide with said transfer module, and the ... objects during their conveyance are brought into an obliquely standing position”²⁷ This process is absent from the “purposes of maintaining the documents in a substantially vertical array”²⁸ taught by Rabindran ‘666; consequently, the assertion by the Examining staff that Rabindran ‘666 discloses,

“method for processing and separating an imbricate formation of flexible, flat objects during product feed, comprising continuously feeding the items (36) in an essentially regular formation to a transfer module (38) ..., wherein flat objects (36) are fluently fed to a guide (near 306) within the transfer module (38), and the flat objects (36) during their conveying are brought into an obliquely standing position (Figs. 7c and 7d) by the guide,”

is unsupported by the express teachings of Rabindran ‘666.

In addition to the foregoing deficiencies, the attention of the Examiner is directed to column 9 of Rabindran ‘666, which teaches that:

“This allows the **first stack** of documents 104 to be placed forward of the forward panel 72 and the **second stack** of document 142 to be placed forward of the rear panel 47. ...

²⁶ Rabindran ‘666, column 2, lines 45-50.

²⁷ Applicant’s Claim 1.

²⁸ Rabindran ‘666, column 2, lines 45-50.

once the **first and second stacks** of documents 140 and 142 have been loaded onto the feed ramp 16, the operator slides the rear panel 74 forward to eliminate any space between the second stack of document 142 and the forward panel 72 as illustrated in Figures 4B and 5B.”²⁹

Applicant’s previous claim 1, as rejected, and Applicant’s newly presented claim 32, as well as withdrawn previous claims 17, 20, 26 and 29 (newly presented claims 48, 51, 57 and 60) contemplate “continuously feeding the items in and essentially regular formation to a transfer module and transferring the items from said transfer module to a conveyer module, wherein flat objects are fluently fed to a guide within said transfer module” In the amended claims, the concept of “product feed” as alternatively defined in these claims, distinguishes Applicant’s invention from the loading of successive “stacks of documents 140 and 142” on two feed ramp 16 as is required by Rabindran ‘666. In view of these and other utterly distinguishing aspects, there is neither anticipation under 35 U.S.C. §102(b) of the basis for maintaining a rejection of any of these pending claims. Accordingly, rejoinder of the non-elected claims and their allowance are respectfully urged.

The Examiner may note that within the United States, it has long been observed that,

“[a]s diversity of ends cannot result from uniformity of means, if the function of the two inventions are essentially distinct the inventions also must be independent of each other, and the question of identity is thus immediately settled.”³⁰

²⁹ Rabindran ‘666, column 9, lines 19-30.

³⁰ *The Law Of Patents For Useful Inventions*, by Wm. C. Robinson, Little, Brown 1890, §274.

Here, where Rabindran '666 teaches a magazine dedicated to the maintenance of "documents in a substantially vertical array",³¹ the "function of the two inventions are essentially distinct inventions" which "must also be independent of each other"; accordingly, the question of anticipation under 35 U.S.C. §102(b) is conclusively determined in the negative. This rejection may not therefore be maintained.

Turning now to previous claim 2, the Examining staff asserts that:

"Regarding claim 2, Figs. 7b-7d show that the flat objects (36) are fed onto a guide surface of the guide (near 306) and are conveyed lying in an overlapping manner, wherein the trailing edge of a flat object in each case lies over the leading edge of the subsequent flat object (Fig. 7b), and the objects (36) during the transport over the guide surface are continuously erected, whereby on removal of the flat objects from the guide the obliquely standing position of the flat objects (36) is inclined opposite to a direction of the conveyance (left to right)."³²

In actuality, Rabindran '666 lacks such aspects of previous claim 2, as for example, Applicant's "the trailing edge of a flat object in each case lies over the leading edge of the subsequent flat object (Fig. 7b), and the objects (36) during the transport over the guide surface are continuously erected, whereby on removal of the flat objects from the guide the obliquely standing position of the flat objects (36) is inclined opposite to a direction of the conveyance (left to right)" because no step is taught by Rabindran '666 where the objects are "continuously erected." Despite the assertions of the Examining staff to the contrary, Figures 7(a), (b), (c) and (d) fail to show the objects being "continuous erected" as taught by Applicant.

³¹ Rabindran '666, column 2, lines 45-50.

³² Paper N^o 051506, page 7.

Under U.S. practice,

“[a] combination, as a whole, possesses attributes distinct from those of its constituent elements and of their co-operative law. It represents an independent and original ideal of means. Its force is a resultant from the union of the individual forces of its elements. Its object is the material on which its functions are performed. Its mode of application is the method in which the co-operating actions of its elements directs its force upon their common object. The *inventive act* by which its is created may manifest itself in the production of a new force by the union of the old, as in a chemical combination; or in the subjection of a new object to the co-operative forces of its elements, as in some special arts; or in the contrivance of a new method for applying these united forces to their object, as in many forms of manufacturers and machines.”³³

This novel act, namely Applicant’s process by which objects in the process defined by previous claim 2 are “continuously erected” is an *inventive act* that is absent from Rabindran ‘666; accordingly, this rejection may not be maintained. Its withdraw and allowance of newly presented claims 32 through 34 and 37 are respectfully urged.

Amendment Of Previous Claim 1 (newly presented Claim 32)

Presently, the only Rabindran *et al* ‘666, has been cited as anticipating previous claim 2 under 35 U.S.C. §102(b). The Examiner states that:

“Regarding claim 2, Figs. 7b-7d show that the flat objects (36) are fed onto a guide surface of the guide (near 306) and are conveyed lying in an overlapping manner, wherein the trailing edge of a flat object in each case lies over the leading edge of the subsequent flat object (Fig. 7b), and the objects (36) during the transport over the guide surface are

³³ *The Law Of Patents For Useful Inventions*, by Wm. C. Robinson, Little, Brown 1890, §281.

continuously erected, whereby on removal of the flat objects from the guide the obliquely standing position of the flat objects (36) is inclined opposite to a direction of the conveyance (left to right)."

Applicant disagrees with the Examiner's argumentation. It is essential for Rabindran's apparatus and method to vertically align the stack of documents, *i.e.* bring the documents in a substantially parallel orientation relative to the backing plate. To achieve this, the documents are "jogged" or "bumped" as described in column 13 lines 22 to 34:

"When the jogger mechanism 354 is activated, any documents 36 in proximity with the wheels 374 are essentially "jogged" or "bumped" or repeatedly and reciprocally displaced relative to the backing plate 320. This causes forwardly leaning documents 36 to be backwardly displaced to become vertically aligned so that they are substantially parallel to the backing plate 320. Such reciprocal displacement of the documents 36 urges the first stack of documents 140 towards a substantially parallel orientation relative to the backing plate 320. However, the wheels 374 need not be configured as an eccentric cam arrangement and may be, for example, linear actuators 374 that traverse a linear path as shown in FIG 7d."

Applicant respectfully notes that contrary to the assertions of the Examiner, Figures 7b does not show documents in a position for removal, but in a unsuitable position leaning backward. Rabindran '666 does definitely not disclose a continuous movement/erection of each single document whereby on removal of the document from the guide orientation the document is in a obliquely standing position inclined opposite to orientation of the document when erected, as claimed in present claim 33.

Claim Rejections - 35 U.S.C. § 103(a)

D. Previous Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bombard '890.

In support of the rejection of previous Claim 3 (and new claim 34) under 35 U.S.C. 103(a) as being rendered obvious, and unpatentable over LaBombard '890, the Examiner states that:

“The LaBombard patent discloses most of the limitations of claim 3 including the fact that the objects can be folded paper boxes (i.e., folded sheets). See, e.g., column 1, line 13. Also, as best understood, Fig. 2 shows that a sheet can in a trailing manner lie over a respective subsequent sheet and the sheets stand obliquely on removal. However, the Bombard patent does not specifically disclose the arrangement of the fold of each sheet, as set forth in claim 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the folded boxes with the fold lying over the respective subsequent folded sheet and with the cut-edge sides facing downward so as to prevent jamming, which may occur when the cut-edges rather than the folded end face upward when the sheets are removed upward by the Bombard apparatus. More specifically, arranging the fold in this manner would prevent fanning out and possible jamming of the cut edge during removal by the Bombard apparatus.”

Applicant submits however, that rejected previous claim 3 and new claim 34 contemplates a particular orientation of objects comprising “folded sheets” and the relation of the “cut-edge size” of those objects; in contradistinction, LaBombard '890 deals with flat blanks 30. Consequently, regardless of whatever orientation LaBombard '890 may display of those blanks, no comparison with the structure defined by Applicant's previous claim 3 is possible; in short, LaBombard '890 fails to either discuss or suggest orientation of folded blanks 30. Consequently, there is no anticipation and withdrawal of this rejection is respectfully urged.

E. Previous Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Rabindran *et al.* '666.

In support of this rejection, the Examiner states that:

The Rabindran *et al.* patent discloses most of the limitations of claim 4 including the fact that the objects can be envelopes and magazines (i.e., folded sheets). See, e.g., column 5, lines 40-53. Also, as best understood, Figs. 7a-7d show that a sheet can in a trailing manner lie over a respective subsequent sheet and the sheets stand obliquely on removal. However, the Rabindran *et al.* patent does not specifically disclose the arrangement of the fold of each sheet, as set forth in claim 4. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the folded sheets with the fold lying over the respective subsequent folded sheet and with the cut-edge sides facing downward so as to prevent jamming, which could possibly occur when the cut-edges rather than the folded end face of a magazine are located near the removal device of the Rabindran *et al.* apparatus.

Contrary to this excerpt from the Office action, rejected previous claim 4 and new claim 35 contemplates "continuously feeding the items in an essentially regular formation in a novel structure and incorporates a guide; in contradistinction, Rabindran '666 fails to appreciate the amenability of continuous feed to improvements within the art, and instead relies upon a structure that successively loads "first and second stacks of documents 140 and 142" onto feed ramp 16. There is therefore, no basis for anticipation, and this rejection must be withdrawn.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

A petition for a one month extension of time and an Applicant's check in the amount of \$120.00 drawn to the order of Commissioner accompanies this response. Should the petition become lost, the Commissioner is requested to treat this paragraph as a petition for an extension of time, and should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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